

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1-17 and 29-41, the only claims pending and currently under examination in this application.

Claim Rejections - 35 USC § 103(a)

Claims 1-17 and 29-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kneezel et al. (US Patent No. 5,939,206), in view of McDevitt et al. (US Patent No. 6,713,298).

In order to meet its burden in establishing a rejection under 35 U.S.C. § 103 the Office must first demonstrate that the combined prior art references teach or suggest all the claimed limitations. See *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007) ("the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make [every element of] the composition or device, or carry out the [entire] claimed process, and would have had a reasonable expectation of success in doing so," (citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007))); and see *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 2007 U.S. App. LEXIS 14308 (Fed. Cir. 2007) ("[t]he Supreme Court recently explained that 'a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,'" (citing *KSR Int'l Co.* at 1741)); and see *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) ("[once] all claim limitations are found in a number of prior art references, the factfinder must determine '[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references,'" (citing *In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004))).

In maintaining the rejection, the Examiner alleges that Kneezel et al. teaches a single orifice plate (31 in Fig. 2), comprising a plurality of orifices (27). The Examiner further alleges that Kneezel teaches a plurality of thermal printhead dyes

each comprising a top surface (a portion of 30, in col. 19, line 56) and bottom surface (bottom surface of element 28), wherein the top surface (30) comprises a plurality of resistors (electrodes 33) and is bonded together to a surface of said orifice plate (31 in Fig. 2). The Examiner notes that “element 30 is considered to be formed of a plurality of portions of element 30, each portion forming a printhead dye” (Office Action, p. 2).

An element of the claimed invention is the presence of multiple printhead dies bonded to an orifice plate. In other words, a single orifice plate has more than one printhead die bonded to it. As reviewed in the specification, a given printhead die includes a set of plural activatable pulse generating members and activation elements therefore on the surface of a substrate. (See page 7, lines 14-21).

For example, a printhead having two printhead dies (A and B), each with five resistors (A 1-5) and (B 1-5), results in printhead die A and printhead die B bonded to the same orifice plate such that five individual orifices align with resistors (A 1-5) and another five orifices align with resistors (B 1-5), respectively.

Turning now to the rejection, Figure 2 of Kneezel is reproduced below for convenience:

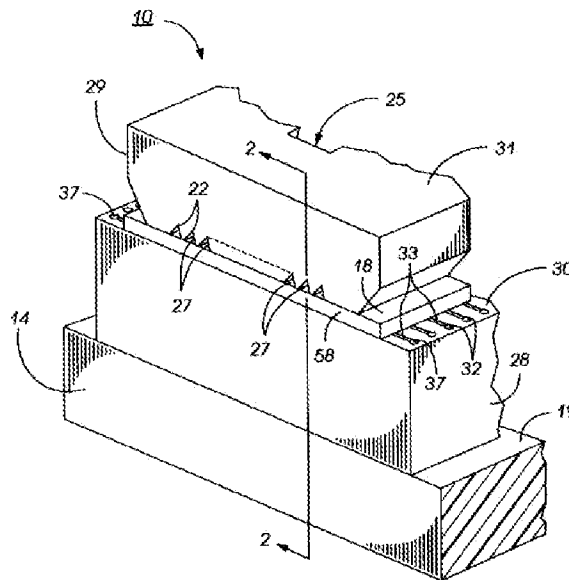


FIG. 2

Examination of Fig. 2 of Kneezel shows top surface 30 of element 28, which the Examiner is equating to “a plurality of thermal printhead dies”. However, the Examiner has not defined what is meant by a “portion” of element 30, wherein each portion forms a printhead dye. It is not clear to the Applicants how surface 30 is allegedly equivalent to the “plurality of printhead dies” of the claimed invention. For example, as in the above discussion, it is not understood how surface 30 can be considered to be comprised of printhead die A and printhead die B, bonded to the same orifice plate, because nowhere in Kneezel is there the teaching or suggestion that surface 30 comprises “portions”.

Furthermore, it is not clear how alleged portions of surface 30 in Kneezel could teach or suggest the element “wherein said printhead comprises from 2 to about 10 printhead dies” as in Claims 2, 11, and 31, or the element “wherein said printhead comprises from 2 to 5 printhead dies as in Claims 3, 12, and 32, or the element “wherein said printhead comprises 3 printhead dies”, as in Claims 4, 13, and 33.

It is also not clear how surface 30, which appears in the drawings and the description of Kneezel to be a single unit, can be considered to be multiple printhead dies which are oriented “parallel to each other”, as in Claims 39-41.

Therefore, Kneezel et al. fail to teach or suggest the claimed element of a plurality of thermal printhead dies bonded to a surface of a single orifice plate, because surface 30 of Kneezel does not contain the element of multiple printhead dies, as the Examiner suggests.

Because McDevitt et al. was cited solely for teaching that an array of biopolymers such as DNA and proteins can be applied onto a substrate through a dispense head that is made using technology essentially identical to that used in “ink-jet” printer heads, McDevitt et al. fail to make up for the fundamental deficiency between Kneezel et al. and the invention in the present case.

As such, Kneezel et al. in view of McDevitt et al. fail to teach or suggest all of the elements of claims. Applicants respectfully request that the rejection of Claims 1-17 and 29-41 under 35 U.S.C. 103(a) be withdrawn.

CONCLUSION

In view of the amendments and remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

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